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WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202

EXAMINER
SHERR, CRISTINA O

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/754,927
Filing Date: January 04, 2001
Appellant(s): PRAKKEN ET AL.

Thomas W. Humphrey, Reg. No. 34,353
Wood, Heron & Evans, L.L.P.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed October 9, 2008 appealing from the Office

action mailed January 9, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,629,980   Stefik et al   5-1997

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Regarding claims 1, 12, and 13 –

Stefik discloses a data file distribution and processing system (e.g. ab, col 3 ln 50-52)

including server software running on a source computer for sending data files to a

destination computer via a network link between the source computer and the

destination computer, and including processing software running on the destination

computer for processing each data file forwarded thereto from said server software to

carry out an action, a method for preventing the processing software running on the

destination computer from processing data files forwarded to the destination computer

other than from the server software, the method comprising the steps of:

including within the server software running on the source computer license

stamping means for embedding a license stamp into each data file before the server

software forwards the data file to said destination computer via said network link (e.g.

col 14 ln 62- col 15 ln7, also an attached "description tree file" for each digital work

"makes it possible to examine the rights and fees for a work without reference to the

content of the digital work" (col 9 ln 27-30). Further, the "description tree for a digital

work is comprised of a set of related descriptor blocks (d-blocks)." (col 9 ln 52-53).

Finally, "a d-block 700 includes an identifier 701 which is a unique identifier for the work

in the repository, a starting address 702 providing the start address of the first byte of

the work, a length 703 giving the number of bytes in the work, a rights portion 704

wherein the granted usage rights and their status data are maintained, a parent pointer

705 for pointing to a parent d-block and child pointers 706 for pointing to the child d-

blocks In the currently preferred embodiment, the identifier 701 has two parts. The first

part is a unique number assigned to the repository upon manufacture." (col 9 ln 55-65).

The unique number assigned to the repository upon manufacture identifies the

repository and lets the recipient or destination computer know whether that repository is

an authorized repository or not); and

   adapting said processing software executed by said destination computer so that

it processes each received data file to carry out said action only when the received data

file contains the embedded license stamp, wherein the license stamp embedded in the

data file indicates that the data file was forwarded by licensed server software (e.g. col

15 ln 6-7, also "the master repository which generated the certificate is not known to the

repository receiving the software, then the software cannot be installed." (col 13 ln 37-

40). Note that the "unique number", above, identifies the repository from which the

digital item has come. Thus, the destination computer is responding to the license

stamp, and "the master repository which generated the certificate is not known to the

repository receiving the software, then the software cannot be installed." (col 13 ln 37-

40). Note that the "unique number", above, identifies the repository from which the

digital item has come. Thus, the destination computer is responding to the license

stamp, by preventing software on the computer from carrying out an action, such as

installation relative to the data file).

   Stefik discloses, in col 42 ln 55-60, for example, a compatibility checking scrip

which contain, inter alia instruction which lead the either installing or not installing the

software. Thus, we have, in Stefik an option code, wherein the options are install or not. Also, at col 13, ln 51-60, Stefik discloses the option of performing a transaction or not depending on the security of the repository. This is an option code. It would be obvious to one of ordinary skill in the art to adapt Stefik to include different options in the option codes, motivated by the needs of the consumers and providers.

Further, Stefik that does not use precisely the same terminology as the instant application, e.g., "ticket" in Stefik, rather than "stamp" in the instant application. Mere renaming, however, does not confer patentability.

Regarding claims 2-11, 13-21, 24-26 –

Stefik discloses the method in accordance with claim 1 wherein said encoded license stamp comprises a code identifying said source computer (e.g. col 13 ln 24-40); wherein said each data file, including its embedded license stamp, is a print file defining a document in a format suitable for directly causing a printer to print said document (e.g. col 4 ln 29-36); wherein said license stamping means embeds said encoded license stamp into the each data file in such a way that said printer ignores the encoded license stamp when printing said document in response to said data file (e.g. col 48 ln 20-26); wherein said action carried out by said processing software comprises displaying on a computer monitor a representation of the document defined by the data file (e.g. col 4 ln 32); wherein said action carried out by said processing software comprises causing said printer to print said document (e.g. col 4 ln 32); wherein solid data file defines a sound and wherein said action carried out by said processing software comprises a initiating said sound (e.g. col 4 ln 32-33); wherein said data file defines a video image and

wherein the action carried out by said processing software comprises initiating a display

of said video image (e.g. col 3 ln 50-55); wherein said license stamping means also

processes each said data file to determine a value of an attribute of the data file and

includes in said embedded license stamp an attribute code indicating said value of said

attribute, and wherein the method further comprises the step of adapting the processing

software to process each received data file to determine a value of said attribute of each

data file received, and to refrain from processing the received data file to carry out said

action unless the received data file includes an embedded license stamp containing

said attribute code indicating a value of said attribute patching the value of said attribute

determined by said processing software (e.g. table 2); wherein the data file processed

by said license stamping means consists of a plurality of data bytes, each of which

influences the value of said attribute determined by said license stamping means (e.g.

table 2); and wherein said license stamping means includes a processing option code

within said license stamp embedded within said data file, and wherein the option code

influences the nature of the output the processing software produces when processing

the data file (e.g. table 2).

Also, an attached "description tree file" for each digital work "makes it possible to

examine the rights and fees for a work without reference to the content of the digital

work" (col 9 ln 27-30). Further, the "description tree for a digital work is comprised of a

set of related descriptor blocks (d-blocks)." (col 9 ln 52-53). Finally, "a d-block 700

includes an identifier 701 which is a unique identifier for the work in the repository, a

starting address 702 providing the start address of the first byte of the work, a length

703 giving the number of bytes in the work, a rights portion 704 wherein the granted

usage rights and their status data are maintained, a parent pointer 705 for pointing to a

parent d-block and child pointers 706 for pointing to the child d-blocks In the currently

preferred embodiment, the identifier 701 has two parts. The first part is a unique number

assigned to the repository upon manufacture." (col 9 ln 55-65). The unique number

assigned to the repository upon manufacture identifies the repository or "source

computer" or "particular server that forwarded the data".

Further, col 8 ln 32-53 discusses a printer as rendering system. It is obvious that

the various digital files must somehow be suitable for printing or else the printer would

not be able to print or render the said files. Further, in Stefik, "To discourage

unauthorized copying of the print outs, it would be possible for the printer to print tracer

messages discretely on the pages identifying the printing transaction, the copy number,

and any other identifying information. The tracer information could be secretly

embedded in the text itself (encoded in the grey scale) or hidden in some other way."

(col 48 ln 20-25). Here rights, license, copy count, etc, are embedded in the printed file.

And, "once a digital work is printed on paper, it can be copied on ordinary

photocopying machines without intervention by a repository to collect usage fees. If the

printer to a digital disk is permitted, then that digital copy is outside of the control of

usage rights." (col 37 ln 9-14).

Further, "(s)uppose that a user logs into a home repository and wants to spool

print jobs for a digital work at a remote printing repository. The user interface for this

could treat this as a request to "spool" prints. Underneath this "spooling" request,

however, are standard rights and requests. To support such requests, the creator of the

work provides a Copy right, which can be used to copy the work to a printing repository.

In the default case, this Copy right would have no fees associated for making the copy.

However, the Next-Set-Of-Rights for the copy would only include the Print rights, with

the usual fees for each variation of printing. This version of the Copy right could be

called the "print spooling" version of the Copy right. The user's "spool request" is

implemented as a Copy transaction to put a copy of the work on the printing repository,

followed by Print transactions to create the prints of the work. In this way, the user is

only billed for printing that is actually done. Furthermore, the rights, conditions and fees

for printing the work are determined when the work is about to be printed." (col 49 ln 62-

col 50 ln 14). Here, the digital files have a code which permits the option of printing or

not. Or rather of merely spooling or spooling and printing. The user is only billed if the

second option (spooling *and* printing) is exercised.

(10) Response to Argument

First Issue

Appellants argue, regarding claim 1, 12, and 23, that nothing in the cited prior

discloses, teaches or suggests a licensing process that controls access to a file or that

prevents a receiver from carrying out actions once the has been received.

Examiner respectfully disagrees and directs attention to Stefik, where, at col 42

ln 55-60, for example, a compatibility checking scrip which contain, *inter alia*,

instructions which lead the either installing or not installing the software. Thus, we

have, in Stefik an option code, wherein the options are install or not. Also, at col 13, ln

51-60, Stefik discloses the option of performing a transaction or not depending on the security of the repository. This is an option code. It would be obvious to one of ordinary skill in the art to adapt Stefik to include different options in the option codes, motivated by the needs of the consumers and providers. These option codes, *inter alia*, prevent actions on a file after the file has been received.

Second Issue

Appellants argue, regarding claim 3-6, 14-17, and 24-25,that nothing in the cited prior art discloses, teaches or suggests embedding a license or any other content in a print file making the print file suitable for causing a printer to print.

Examiner respectfully disagrees and directs attention to Stefik at col 19 ln 35-40 where digital files have rights attached to them, and where at col 13 ln 50-57 said rights include being printed by a printer or otherwise rendered. Thus, the right to print is not converted from another right.

Third Issue

Appellants argue, regarding claims 4, 15, and 25, that nothing in the cited prior art discloses, teaches or suggests, ignoring a licensing stamp so that when printing a document.

Examiner respectfully disagrees and directs attention to Stefik at col 19 ln 55-58, where at printing the work is not further protected by usage rights.

Fourth Issue

Appellants argue, regarding claims 5 and 16, that nothing in the cited prior art discloses, teaches or suggests, displaying a print file.

Examiner respectfully disagrees and directs attention to Stefik, at col 9 ln 1-5,

where a rendering repository is described as a display/execution repository and one of

the types of execution is printing and col 16 ln 59 where the user interface includes a

display.

Fifth Issue

Appellants argue, regarding claim 7-12 and 18-21, that nothing in the cited prior

art discloses, teaches or suggests a license stamp that includes an attribute code that

causes the destination computer to refrain from processing the file to carry out an

action.

Examiner respectfully disagrees and directs attention to Stefik, where, at col 42

ln 55-60, for example, a compatibility checking scrip which contain, *inter alia*,

instructions which lead the either installing or not installing the software. Thus, we

have, in Stefik an option code, wherein the options are install or not. Also, at col 13, ln

51-60, Stefik discloses the option of performing a transaction or not depending on the

security of the repository. This is an option code. It would be obvious to one of ordinary

skill in the art to adapt Stefik to include different options in the option codes, motivated

by the needs of the consumers and providers. These option codes, *inter alia*, prevent

actions on a file after the file has been received.

Sixth Issue

Appellants argue, regarding claims 10 and 21, that nothing in the cited prior art

discloses "that the number of bytes in the data file influences the value of an attribute in

the license stamp".

Examiner respectfully disagrees. Firstly, nothing in claims 10-21 appears to disclose "that the number of bytes in the data file influences the value of an attribute in the license stamp". Secondly, as above, attention is directed to Stefik, where, at col 42 ln 55-60, for example, a compatibility checking scrip which contain, *inter alia*, instructions which lead the either installing or not installing the software. Thus, we have, in Stefik an option code, wherein the options are install or not. Also, at col 13, ln 51-60, Stefik discloses the option of performing a transaction or not depending on the security of the repository. This is an option code. It would be obvious to one of ordinary skill in the art to adapt Stefik to include different options in the option codes, motivated by the needs of the consumers and providers. These option codes, *inter alia*, prevent actions on a file after the file has been received.

Seventh Issue

Appellants argue, regarding claims 11 and 22 that nothing in the cited prior art discloses, teaches or suggests, hat a processing option code is included in the license stamp and influences the nature of the output of the processing software in the destination computer.

Examiner respectfully disagrees and directs attention to Stefik, where, at col 42 ln 55-60, for example, a compatibility checking scrip which contain, *inter alia*, instructions which lead the either installing or not installing the software. Thus, we have, in Stefik an option code, wherein the options are install or not. Also, at col 13, ln 51-60, Stefik discloses the option of performing a transaction or not depending on the security of the repository. This is an option code. It would be obvious to one of ordinary

skill in the art to adapt Stefik to include different options in the option codes, motivated

by the needs of the consumers and providers. These option codes, *inter alia*, prevent

actions on a file after the file has been received.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the

Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Cristina Owen Sherr /C.O.S./
Examiner, Art Unit 3685

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685

Conferees:

/C.L.H./
Calvin L Hewitt II
Supervisory Patent Examiner, Art Unit 3685

/A. J. F./
Andrew J. Fischer
Supervisory Patent Examiner, Art Unit 3621